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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY-DOCKET NO.	CONFIRMATION NO.
09/183,791	10/30/1998	PETER G. JACOVES	FMSI-24.440	3525

7590 11/21/2001  
Thomas R. Felger, Esq.  
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EXAMINER

KAZIMI, HANI M

ART UNIT PAPER NUMBER

2164

DATE MAILED: 11/21/2001

#24

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/183,791

Applicant(s)

JACOVES ET AL.

Examiner

Hani Kazimi

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51, 53, 54, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51, 53, 54, 56, and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

1. This communication is in response to the Request for Continued Examination (RCE) filed on August 24, 2001.

#### ***Status of Claims***

2. Of the original claims 1-46, claims 1-5, 17, 19, 23, 25-29, 39, 41, and 45 have been amended in the amendment filed on October 15, 1999. In the amendment filed on May 10, 2000, claims 1-3, 6-10, 12, 14-27, 30-34, 36-38, 40, 41, and 43-46 have been amended, and claims 47-51 have been added. Claims 1, 6, 23-25, 45-47, and 51 have been amended, and claims 52-57 have been added in the amendment filed on December 11, 2000. In the amendment filed on August 24, 2001, Claims 52, and 55 have been canceled. Therefore, claims 1-51, 53, 54, 56, and 57 are under prosecution in this application.

#### ***Summary of Office Action***

3. Applicants' arguments filed on August 24, 2001 have been fully considered, and discussed in the next section below or within the following rejections under 35 U.S.C. § 103 are not deemed to be persuasive. Therefore, claims 1-51, 53, 54, 56, and 57 are rejected as being unpatentable over the art cited below, and Applicant's request for allowance is respectfully denied.

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***Response to Applicants' Amendment***

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

6. Claims 1-51, 53, 54, 56, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. European Pat. No. 0 511 463 A2.

Claims 1-51, 53, 54, 56, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. as discussed in paragraphs 5, and 9, of paper number 16.

Further: Greer teaches the steps of providing the discount in the subsequent purchase transaction at the subsequent vendor; and receiving a reimbursement for the discount from each

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manufacturer of the discount triggering items at the subsequent vendor, the reimbursement for each manufacturer based on the bundle totals associated with the bundles comprising the discount triggering items for the manufacturer (col. 2, line 54 thru col. 3, line 55, and column 5, line 30 thru column 9, line 51).

Greer fails to teach that the subsequent vendor is distinct from the initial vendor.

Official Notice is taken that issuing a coupon to a consumer at an initial vendor that is redeemable at a subsequent vendor distinct from the initial vendor is old and well known in the art. For example, in the air line industry, a consumer that flies so many miles is offered discount coupons for rental cars. The fact that the subsequent vendor comprising a gas station and the initial vendor comprising a grocery store, and the pre-determined redeemable item comprising fuel is just a field of use.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Greer to include that the subsequent vendor is distinct from the initial vendor, because the system is benefiting consumers, vendors, and manufacturers by automatically rewarding the purchase of a variety of selected products, and to ensure purchase of the discounted product, see Greer (col. 2, lines 7-19).

### ***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The response to Applicant's arguments with respect to the claims is mentioned above within the 35 U.S.C. 103 rejections of this office action.

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***Conclusion***

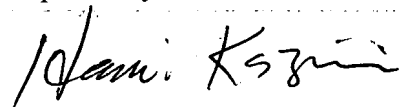
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703) 746-7239 or 7240.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Respectfully Submitted



Hani.Kazimi

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November 19, 2001